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22850 7590 05/06/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, HAI	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/725,511
Filing Date: November 30, 2000
Appellant(s): ISHIZUKA, HIROAKI

James J. Kulbaski
Surinder Sachar
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 3, 2008 appealing from the Office action mailed June 13, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,055,573	Gardenswartz et al.	04-2000
6,092,053	Boesch et al.	07-2000
5,826,241	Stein et al.	10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The rejections are copied from the final office action mailed on June 13, 2007.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 16-19, 22-30, 39-42, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al. (U.S. Patent No. 6,055,573) ("Gardenswartz") in view of Boesch et al. (U.S. Patent No. 6,092,053) ("Boesch").

3. Gardenswartz discloses a method, system and computer program product for delivering a targeted advertisement based on a customer's off-line purchase history (Abstract).

4. **Regarding Claims 1 and 24**, with respect to a method and system of communicating, comprising the steps of: storing a customer's financial information in a supplier computer system based on an off-line transaction of a completed purchase or lease of equipment between a customer and a supplier (see col. 10, lines 35-63, figure 6/elements 50, 51, 52); beginning an on-line purchase, subsequent to the completed off-line transaction, by the customer with the supplier and communicating to a server computer by the customer (see col. 13, lines 51-24, figure 9/elements 78, 80, 82 and

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note below); determining whether the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction (see figure 8/element 70, col. 12., lines 65-67, figure 10/element 1000, col. 15, lines 19-40); communicating to the customer that the on-line purchase has been approved, when said determining step determines that the customer is an acceptable credit risk (see figure 10/element 1002, col. 15, lines 41-54).

5. Gardenswartz teaches delivering a targeted advertisement online based on the customer's off-line purchase history, but does not expressly disclose that the purchases are on-line, offline or both. However, Boesch teaches a system and method where certain consumer information is stored on a server and is provided to a merchant to allow the consumer to purchase a product or service on-line in an easy and safe manner (Abstract).

6. It would have been obvious to combine the teachings of Gardenswartz, related to communicating with consumer over the network, with the teachings of Boesch, related to electronic commerce allowing consumers to purchase items on-line and merchants to receive payment information relating to the purchases, to offer an improved electronic commerce system as described in Gardenswartz at (see col. 7, lines 51-54).

7. **Regarding Claims 2 and 25**, Gardenswartz teaches storing the customer's financial information based on a lease or value contract (see col. 3, lines 61-65).

8. **Regarding Claims 3-5 and 26-28**, these claims involve identifying a particular type of transaction whereby financial information is obtained. The particular

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transactions described are leases or purchases of copying and imaging equipment.

Although Gardenswartz does not expressly teach purchasing or leasing an image forming device (i.e. copier, facsimile machine, etc.), the Examiner interprets that the customer's offline purchase history would have included a purchase of an image forming device as such device is so popular in today's computer world.

9. **Regarding Claims 6-7 and 29-30**, Gardenswartz teaches determining the customer is an acceptable credit risk based on the purchase history database for receiving a value contract offer and offering a new value contract (see figure 1/element 16, col. 6, lines 63-10 of col. 7, figure 10/elements 1000, 1014, col. 15, lines 19-40, col. 16, lines 56-2 of col. 17). The Examiner interprets that the customer would not be offered a new value contract if he did not have up-to-date payments on previous value contract.

10. **Regarding Claims 16-18 and 39-41**, Gardenswartz does not expressly teach debiting a bank account electronically and charging a third party credit card for the on-line transaction. Boesch teaches using consumer's personal information (e.g. credit card number, etc.) to complete the transaction (see col. 3, lines 55-61). One of ordinary skill in the art would have combined the teachings of Gardenswartz with the teaching of Boesch to offer an improved electronic commerce system as described in Gardenswartz at (see col. 7, lines 51-54).

11. **Regarding Claims 19 and 42**, Gardenswartz does not expressly teach issuing a paper bill if financial information is not valid. Boesch teaches a method and system comprising: issuing a paper bill for said transaction if said financial information is not

valid (see address at col. 3, lines 55-61). One of ordinary skill in the art would have combine the teachings of Gardenswartz with the teaching of Boesch to offer an improved electronic commerce system as described in Gardenswartz at (see col. 7, lines 51-54).

12. **Regarding Claims 22-23 and 45-46**, Gardenswartz teaches that if a customer purchases products through the on-line purchase are different than the offline purchase history, the customer is reclassified by assigning an updated purchase behavior classification (see col. 4, lines 13-24).

13. Claims 8-15, 20-21, 31-38, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz in view of Boesch and further in view of Official Notice.

14. **Regarding Claims 8-15, 20-21, 31-38, and 43-44**, these claims focus exclusively on bill distribution and presentment. These claims are unrelated to the concept of using previously acquired off-line information in making a credit risk determination to a current transaction. The Examiner takes an Official Notice of these claims, and observes that it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to modify the teachings of Gardenswartz in combination with Boesch to include a variety of bill presentment options. The motivation for such a combination is within the general knowledge of one of ordinary skill in the art and is simply to provide as many options as possible, to both vendor and customer, so as to facilitate prompt payment.

(10) Response to Argument

Independent Claims 1 and 24

The appellant argues:

A). Gardenswartz reference fails to disclose or suggest “determination of whether the customer is an acceptable credit risk for an on-line purchase using the customer’s financial information, based on a prior off-line transaction” (see page 6, second paragraph of the appeal brief). Appellant recites “determining whether the customer is an acceptable credit risk for the on-line purchase using the customer’s financial information in the supplier computer system and which is based on the off-line transaction” (see page 6, third paragraph, and page 8, second paragraph of appeal brief) and argues that this feature is not disclosed in Gardenswartz.

B). the “value contract” in Gardenswartz is an in-store promotion for a consumer to visit a retail store while Appellant’s claims are directed to an “on-line transaction” (see page 7, second paragraph thru first paragraph in page 8 of appeal brief).

C). Boesch reference does not cure the deficiencies in Gardenswartz because Gardenswartz is directed to a contrary objective and thus could not have been modified by Boesch to meet the claimed features (see page 8, third paragraph of appeal brief).

Response to A

Examiner asserts that the Appellant’s claimed invention does not require the extension of credit, rather it only requires the determination of credit risk. Based on Appellant's specification, Appellant defines the determination of credit risk as merely "a

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simple determination as to whether or not the customer is current on his lease and/or purchase payments” (see page 11, lines 14-17 of Appellant's specification). This is exactly what is taught by Gardenswartz. Gardenswartz teaches determining whether a value contract should be awarded to a customer based the customer's observed offline purchase history (see column 12, lines 65-67, figure 8/element 70; column 15, lines 19-40, figure 10/element 1000). Examiner interprets that the customer would not be offered a value contract if his purchase payment is not current and cited this in the Final Office Action (see pages 3-4, paragraphs 10-11, and pages 4-5, paragraph 14).

Response to B

With respect to “lease” vs. “value contract”, Examiner would like to point out that a “lease” in the Appellant's claims is an example, not a feature of novelty. Based on Appellant's specification (see page 7, lines 16-17) where it clearly states that “The lease database 224 is not necessary or essential to the present invention, specifically when the off-line transaction does not involve a lease”. In addition, claims 1 and 24 recite “based on an off-line transaction of a completed purchase or lease of equipment”. Hence, the claimed feature is basically anything related to financial transaction. This is what is taught by Gardenswartz where a consumer is determined whether he should be awarded a value contract based on the purchase history (see column 15, lines 20-22).

With respect to “on-line transaction” vs. “in-store visit”, Examiner had acknowledged this difference and cited it in the Final Office Action (see page 3, paragraph 10). Boesch teaches a system and method where consumer information is stored on a server and provided to a merchant to allow the consumer to purchase a

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product or service on-line and that a combination of both references would disclose the claimed features (see pages 3-4, paragraphs 10-11).

Response to C

With respect to Boesch reference, Examiner had cited that Boesch cures such deficiencies in Gardenswartz, and provided a motivation to combine both references that would disclose the Appellant's claimed features in the Final Office Action (see pages 3-4, paragraphs 10-11). Appellant did not explain why Boesch does not cure the deficiencies and simply stated that Gardenswartz is directed to a contrary objective and could not have been modified by Boesch to meet the claimed features (see page 8, third paragraph of appeal brief). Examiner respectfully disagrees. Gardenswartz teaches communicating with consumer over the network, and Boesch teaches electronic commerce allowing consumers to purchase items on-line. Both Gardenswartz and Boesch are within the general knowledge of one of ordinary skill in the art and there is a clear motivation that a combination of them would provide more options to both vendor and customer.

Dependent Claims 2 and 25

Appellant argues that Gardenswartz discloses a "value contract" is not directed to an off-line transaction of a lease. Examiner respectfully disagrees. With respect to "off-line transaction", Examiner had cited that Boesch cures such deficiencies in Gardenswartz (see pages 3-4, paragraphs 10-11 in Final Office Action). With respect to "lease", Appellant's specification (see page 7, lines 16-17) clearly states that a "lease"

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database is not necessary or essential to the invention. In addition, Examiner notes that Gardenswartz could have been easily modified to include a "lease" in its invention and that a combination of both Gardenswartz and Boesch would disclose an off-line transaction of a lease.

Dependent Claims 3-5 and 26-28

These claims involve identifying a particular type of transaction whereby financial information is obtained. The particular transactions described are leases or purchases of copying and imaging equipment. Although Gardenswartz does not expressly teach purchasing or leasing an image forming device (i.e. copier, facsimile machine, etc.), Examiner interprets that the customer's off-line purchase history would have included a purchase of an image forming device as such device is so popular in today's computer world.

Dependent Claims 6, 7 and 29, 30

Gardenswartz teaches determining the customer is an acceptable credit risk based on the purchase history database for receiving a value contract offer and offering a new value contract (see column 15, lines 19-40; figure 10/element 1000). Examiner interprets that the customer would not be offered a new value contract if he did not have up-to-date payments on previous value contract.

Dependent Claims 8-15, 20-21, 31-38, and 43-44

With respect to the Official Notice, Examiner provides a brief history of it in the following:

The Official Notice was taken in the Non-Final Office Action, issued on January 26, 2007. Appellant did not traverse the Official Notice in his follow-up Amendments/Remarks, replied on March 19, 2007.

Examiner used the same Official Notice in the Final Office Action, issued on June 13, 2007. However, Appellant traversed the Official Notice in the Post Final Office Action Amendment, replied on September 13, 2007.

Examiner responded only the broadest concern in the Appellant's Post Final Office Action Amendment in the Advisory Action, issued on October 1, 2007, and it was deemed by the Examiner and his Supervisor that only the broadest concern need to be responded.

Regardless, Examiner identified a prior art (see U.S. Patent No. 5,826,241, issued to Stein et al., October 20, 1998) for features related to bill distribution and presentment. Stein teaches a system and method for making payment and authenticating transactions over the internet.

In conclusion, Examiner notes that these claims focus exclusively on bill distribution and presentment and are unrelated to the concept of using previously acquired off-line information in making a credit risk determination to a current transaction. Hence, the Examiner takes an Official Notice of these claims (see claims rejection above).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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